

## REMARKS

Claims 11-18 and 22 are pending.

Applicants thank the Examiner for considering and entering applicants' last Response and Amendment, and for withdrawing particular rejections asserted therein.

Applicants acknowledge the Examiner's current rejection of claims 12-14, under 35 U.S.C. § 112 ¶1, alleging new matter with respect to recitation of "radiolabels, fluorescent labels and combinations thereof" (claim 12), recitation of any labeled dNTP (claims 13 and 14). Applicants have amended the claims to obviate these rejections.

Applicants acknowledge the Examiner's rejections of claims 11-18 and 22, under the judicially-created doctrine of non-statutory double patenting in view of applicants' U.S. Patent No. 6,251,594, and in view of applicants' U.S. Patent No. 6,811,982). The present application is commonly owned with the allegedly conflicting Patents, and applicants are prepared to file a Terminal Disclaimer in compliance with 37 C.F.R. 3.73(b) upon indication of allowable subject matter.

No new matter has been added.

## FORMALITIES

Applicants, in view of U.S. Patents 6,251,594 and 6,811,892, are prepared to file a Terminal Disclaimer in compliance with 37 C.F.R. 3.73(b) upon indication of allowable subject matter in the present prosecution. Applicants will also file supplementary inventor declarations upon such notice.

### *Rejection under 35 U.S.C. § 112 ¶1; new matter*

The Examiner rejected claims 12-14, under 35 U.S.C. § 112 ¶1, alleging 'new matter' with respect to recitation of "radiolabels, fluorescent labels and combinations thereof" (claim 12), and recitation of "any labeled dNTP" (claims 13 and 14) (Office Action of 15 May 2005 at pages 2-4). Applicants have amended the claims to obviate these rejections.

Specifically, applicants have responsively amended claim 12 by deleting the phrase "and

combinations thereof,” and have thus addressed the Examiner’s asserted lack of support for the recitation of *combinations* of radiolabels and fluorescence labels. Applicants respectfully maintain for reasons already of record that the originally filed specification supports recitation of dNTPs labeled with radiolabels or fluorescent labels, which is in keeping with the Examiner’s Amendment of 11 May 2004 in applicants’ sister (*continuation*) Application Serial No. 10/109,725 that led to issuance of as U.S. Patent 6,811,982, claim 5 of which recites “dNTPs are labeled with a label selected from the group consisting of radiolabels and fluorescent labels” in the context of essentially the same methods steps presently recited, and based on the same specification.

Additionally, applicants have further conformed dependent claim 12 to independent claim 1 by reciting the phrase “and wherein determining the identity of the first primer-extended base is by measuring incorporation of the labeled dNTPs.”

Finally, applicants have responsively amended claims 13 and 14 to recite “[<sup>32</sup>P]-labeled dCTP, [<sup>32</sup>P]-labeled TTP, and combinations thereof,” thus addressing the Examiner’s comments with respect to these claims. No new matter has been added.

Applicants, therefore, respectfully request withdrawal of the Examiner’s 35 U.S.C. § 112 ¶1-based rejection of claims 12-14 as currently amended.

### ***Rejection under 35 U.S.C. § 112 ¶2***

The Examiner rejected claims 13 and 14, under 35 U.S.C. § 112 ¶2, as being indefinite for recitation of “the labeled dNTP,” for lack of antecedent basis (Office Action of 15 March 2005, at page 4).

Applicants have amended claims 13 and 14 to replace “labeled dNTP” with “dNTPs,” to conform with independent claim 1, and have further clarified the claim by reciting that “dNTPs for top [or bottom in the case of claim 14] strand analysis comprise a radiolabeled NTP selected from the group consisting of.....” Support for these amendments is found throughout the originally filed specification, and particularly, for example, under Example 1, page 11, and in originally filed claims 2 and 3, reciting specific [<sup>32</sup>P]-labeled nucleotides for top and bottom strand analysis.

Applicants, therefore, respectfully request withdrawal of the Examiner's 35 U.S.C. § 112 ¶2 rejection in view of amended claims 13 and 14.

### ***Non-statutory Double Patenting Rejections***

The Examiner has, in view of applicants' U.S. Patent No. 6,251,594 (the '594 patent ) and in view of applicants' U.S. Patent No. 6,811,982 (the '982 patent ), rejected claims 11-18 and 22, under the judicially-created doctrine of non-statutory double patenting, as claiming essentially the same invention as that of claims 1-11 of the '594 patent, and claims 1-10 of the '982 patent (Office Action of 15 March 2005, at pages 4-6).

Specifically, the Examiner asserts that some of the presently claimed subject matter, while not identical to, is nonetheless not patentably distinct from that claimed in the '594 and '892 patents.

Applicants maintain that the present application is commonly owned (ASSIGNEE: University of Southern California, a not-for-profit corporation of the State of California, having administrative offices at 3716 Hope Street, Suite 313, Los Angeles, CA 90007-7377) with the allegedly conflicting '594 and '892 patents, and applicants are prepared to file timely Terminal Disclaimers in compliance with 37 C.F.R. 3.73(b) upon the Examiner's indication of allowable subject matter.

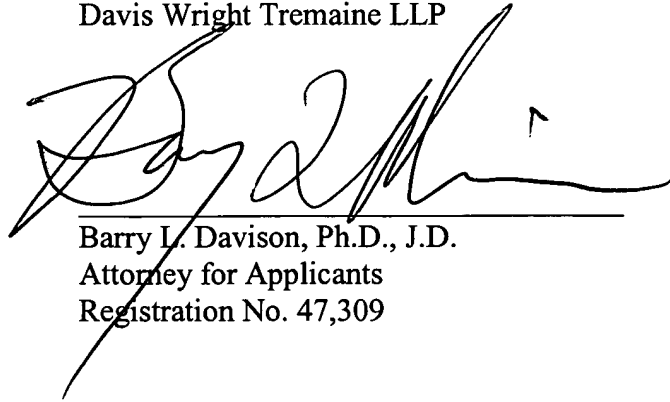
### **CONCLUSION**

In view of the foregoing amendments and remarks, applicants respectfully request entry of the present Response and Amendment, and allowance of all claims 11-18 and 22. No new matter has been added.

The Examiner is encouraged to phone applicants' attorney, Barry L. Davison, to resolve any outstanding issues and expedite allowance of this application.

Respectfully submitted,

Davis Wright Tremaine LLP

A handwritten signature in black ink, appearing to read 'Barry L. Davison', is written over a horizontal line. The signature is stylized with a large initial 'B' and a long, sweeping tail.

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